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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/061,706	04/17/1998	JEFFREY OWEN KEPHART	YO998-143	2021

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IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
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EXAMINER
BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/061,706	KEPHART ET AL.	
	Examiner	Art Unit	
	William L. Bashore	2176	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *03 September 2002*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Joseph H. Feild
JOSEPH H. FEILD
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant requests the examiner to reconsider and elaborate upon his analysis of Applicant's Rule 132 Declaration, filed February 28 2002 (as paper No. 21), said declaration submitted as evidence traversing a prima facie case of obviousness. The examiner notes that Applicant has failed to establish a clear nexus between the evidence of secondary considerations and the merits of the claimed invention for at least the following reasons:

Exhibit A is directed towards a user satisfaction evaluation of Smartlook. However, the result of said evaluation is merely a statement that users over-estimate Smartlook's performance (Exhibit A, second page, column 1, paragraph 2, 3), and thus is an opinion, rather than evidence of success.

Exhibit B - page 160, presents suggestion accuracy of SwiftFile, not actual accuracy. The presented simulations are used to determine retroactively how accurate SwiftFile would have been in predicting the folder of a new message, therefore, said data is used in predicting accuracy, not actual accuracy.

Applicant's argument (page 2 - paragraph 6 of the declaration) regarding over three thousand downloads since the Website was set up, does not in itself indicate commercial success, since many other reasons for downloading SwiftFile may be involved (i.e. creation of a Web membership registration as indicated on download page, cost, and/or inquisitiveness). Although number of downloads is quantified, it is unclear how many downloads translate into actual installations of SwiftFile.

Applicant argues on pages 2-3 (paragraph 8) of the declaration, that Applicant's interface of using "one-click" classification is non-obvious over the prior art as indicated by increased speed. The examiner notes that when comparing application execution speeds taking into account the number of activated buttons, with all else being equal, single-click activation will result in faster application speed than multiple-click activation, simply because of reduced processing time required for single-click activation.

Exhibit C (page 1 - Introduction) presents the statement that subsequent to a correct guess, clicking on a corresponding button saves oneself the mental and physical effort of selecting a correct folder via the usual methods, thus providing evidence of a long-felt need over the prior art regarding Applicant's one-click feature. The examiner notes that Applicant's claimed invention must satisfy a long-felt need which was recognized, persistent, and not solved by others (MPEP 716.04). In the present case, this need is solved by the cited prior art (Lewak), which teaches activating a single "Categorize" button for recategorizing a file, said activation not requiring any further file identification (Lewak column 9 lines 5-10, 50-55, Figure 5 item 60).

In view of the strength of the cited art of record applied to the present round of rejections, and Applicant's failure to establish a clear nexus between the evidence and the merits of the claimed invention, the examiner has determined that Applicant's declaration does not overcome the obvious rejections of claims 11-21, and 23-63.